

## **REMARKS**

### **Summary of Examiner's Action**

In the subject office action, the Examiner rejected claims 1-7 & 9-55. More specifically, the Examiner rejected

- claims 1, 3, 5-6, 9, 12-14, 20 under 35 USC 103(a) as being unpatentable over Hunt et al (USP 6,496,855), in view of Scheussler and Moon combined.
- claims 21-27, 28-32, 39-41, 43-49 under 35 USC 103(a) as being unpatentable over Hunt et al (USP 6,496,855), in view of Scheussler and Moon combined,
- claims 2, 4, 7, 10, and 11 under 35 USC 103 as being unpatentable over Hunt in view of Scheussler, Moon and Linden combined;
- claims 15 under 35 USC 103 as being unpatentable over Hunt in view of Scheussler, Moon and Kamiya combined,
- claims 16-19, under 35 USC 103 as being unpatentable over Hunt in view of Scheussler, Moon, Kamiya and Flemming combined, and
- claims 33-38 and 50-55 under 35 USC 103 in view of Hunt Kamiya and Flemming combined.

However, the Examiner did not provide a detailed reason for rejecting claim 42.

### **Rejections of claims 1, 3, 5-6, 9, 12-14, and 20**

In response, claims 1, 5, 9, 13 and 14 have been amended. In particular, claim 1 has been amended to include the limitations of

wherein either the first and second email addresses were simultaneously pre-provided to the user computer by the email service provider, or each of the first and second email addresses is provided to the user computer by the email service provider in real time in response to a first and a second request post enrollment of the user as a service subscriber of the email service provider, respectively.

The Examiner acknowledged that the limitations of "provision of the first and second email addresses from the email service provider to the user computer" was not taught by Hunt, nor Scheussler, but asserted that this deficiency is remedied by Moon, in particular its teaching on (col 1, lines 20-28).

In the subject passage, Moon stated

"Generally, a user opens up an account with the mail service provider(s) of his/her choice ... The user also receives an address or "mailbox" with the mail service provider's network at which electronic mail item addressed to the user are received and stored." (emphasis added)

Thus, in the subject passage, Moon merely taught

- a) provision of a single address or mailbox,
- b) this single address or mailbox identifies a location in the service provider's network at which the electronic mail items addressed to the user are received and stored (which Applicant submits is an URL to the subscribing user's account, and not an email address, as an email address identifies a destination to send an email to a user, not a location where the emails addressed to the user are stored); and
- c) where (a) and (b) occur during the opening of the user account.

Accordingly, even if we assume (b) can be read as an email address (which Applicant does not agree), the amendment nevertheless clarified that the required provision of the first and second email addresses by the email service provider has to be

either simultaneously pre-provided to the user computer by the email service provider,

or each of the first and second email addresses is provided to the user computer by the email service provider in real time in response to a first and a second request post enrollment of the user as a service subscriber of the email service provider, respectively

Even if we are to ignore the above deficiency of Moon, the Examiner's implicit assertion that one of ordinary skill in the art would be motivated to employ Scheussler and Moon to modify Hunt to arrive at the present invention is a conclusionary assertion, unsupported by any evidence with respect to why one of ordinary skill in the art would be motivated to do so.

Applicant respectfully reminds the Examiner that in obviousness rejections, the Examiner must view the invention as a whole as required by the literal language of section 103. When viewed as a whole, Hunt teaches a fundamentally different approach from the present invention, an agency approach, where the service provider generates the email addresses, performing the registrations with the respective web sites using the generated email addresses, and receiving/processing emails addressed to the generated email addresses, whereas the present invention as claimed by claim 1, is directed towards an approach where the email service provider's role is limited to the provision of the email addresses and processing of the emails addressed to the provided email addresses. Registrations with the websites, including provision of the respective email addresses are performed by the user computer. If the Examiner is to maintain the rejection with Moon or a replacement art, Applicant respectfully requests the Examiner to provide evidence to support why one of the ordinary skill in the art would be motivated to modify Hunt's complete agency approach to Applicant's limited agency approach.

Thus, for at least the forgoing reasons, Applicant submits amended claim 1 is patentable over Hunt, even in view of Scheussler and Moon.

Claims 3, 5-6, 9, 12-14 and 20 are dependent on claim 1 (directly or indirectly), incorporating its limitations. Therefore, for at least the same reasons,

claims 3, 5-6, 9, 12-14 and 20 are also patentable over Hunt, even in view of Scheussler and Moon.

Further, these claims contain additional limitations that render them further patentable over Hunt, Scheussler and Moon beyond the patentability of claim 1.

As a first example, amended claim 13 requires the user computer to inform the email service provider the names of the websites the user computer is using the provided email addresses for, "integrally as said first/second email address is provided to said user computer for use to register the user with the first/second web site". Since the Examiner already acknowledged that Hunt does not teach provision of email addresses from the email service provider to the user computer, it follows, Hunt could not possibly teach the user computer informing the email service provider the website an email address is being used for "integrally as said first/second email address is provided to said user computer for use to register the user with the first/second web site".

As a further example, similarly, amended claim 14 requires the user computer to inform the email service provider the names of the websites the user computer is using the provided email addresses for, "in batch" subsequent to the provision of the email addresses to the user computer by the email service provider. Again, since the Examiner already acknowledged that Hunt does not teach provision of user email addresses from the email service provider to the user computer, it follows, Hunt could not possibly teach the user computer informing the email service provider the websites the provided email addresses are being used "in batch", subsequent to the provision of the email addresses to the user computer by the email service provider.

Rejection of claims 21-27, 28-32, 39-41, 43-49 under 35 USC 103(a)

Claims 22-24, 28-32, 41, and 45-49 have been amended. Claims 22-24 are not amended to overcome the references.

Claim 21 recites

an electronic device (e-device) obtaining a plurality of distinct email addresses from an email service provider;  
the e-device selecting a first of said distinct email addresses to facilitate communication with a first communication partner or group of communication partners (CP/GCP); and  
the e-device selecting a second of said distinct email addresses to facilitate communication with a second CP/GCP.

As discussed earlier, contrary to the Examiner's assertion, Moon does not teach provision of a destination email address to the user computer, merely an address identifying where emails are stored, which may e.g. be an URL. Further, even if the teaching is so read, Moon still merely teaches the provision of a single "address".

Thus, even if we are to further ignore that, Hunt in col. 7, lines 14-16, nevertheless still merely teaches the email address is generated "when a site request the user's email address". Accordingly, even if we are to further ignore the fact that the distinct email addresses of claim 21 are "obtained", Hunt still contains no teaching on "selecting an email address from a number of (obtained) distinct email addresses", regardless who does the selection, as if the email addresses are generated in real time, there isn't any existing pre-generated email addresses to select from.

Even if we are to further ignore that, as discussed earlier, the Examiner still has not provided evidence to support why one of ordinary skill in the art would be motivated to implement this "selection" ability on the user computer in substitution for the "selection" ability of the email service provider (if it was taught), especially if the approach remain a complete agency approach with the email service provider performing the registration. If the Examiner were to assert that selection by the user

computer would be a natural implementation for a limited or non-agency approach, the question remains then, what evidence is there to support that one of ordinary skill in the art would modify Hunt's complete agency approach to Applicant's limited agency approach.

Accordingly, for at least these reasons, Applicant submit claim 21 is patentable over the cited references.

Claims 22-23 are dependent on claim 21, incorporating its limitations, therefore, for at least the same reason, claims 22-23 are patentable over the cited references.

Claims 22-23 contain additional limitations, they are further patentable over the cited references for the same reasons earlier discussed for claims 13-14.

Claim 24 has been amended to clarify that all the recited operations are performed for the same user. Hunt, on the other hand, in col. 7, lines 14-16, merely teaches the web site requesting for a email address for a new user. While certainly the email address obtained by the web site is for communication with the user, however, it is not between the user and another communication partner (which by well established claim construction rule is a different entity from the "e-device").

Even if we are to ignore that, if the website ever request the agent system for another email address, it will be for a different user, with whom the website wants to communicate. The web site does not make a subsequent request for another email address for the same user for whom it has already have an email address.

Thus, for at least these reasons, claim 24 is also patentable over the cited references.

Claims 25-27 are dependent on claim 24, incorporating its limitations, therefore, for at least the same reasons, claims 25-27 are patentable over the cited

references. Additionally, claims 26-27 are further patentable over the cited references, for at least the same reasons earlier discussed for claims 13-14.

Claims 28-32 recite substantially the same limitations as claims 21-27, from the email service provider's perspective. Accordingly, for at least the same reasons, claims 28-32 are patentable over the cited references.

Claims 39 and 40 contain similar limitations as original claims 21 and 24. Accordingly, for at least the same reasons, original claims 39 and 41 are patentable over the cited references.

Claim 41 contains similar limitations as amended claim 24. Accordingly, for at least the same reasons, amended claim 41 is patentable over the cited references.

Claims 43-44 are dependent on claim 41, incorporating its limitations, therefore, for at least the same reasons, claims 43-44 are patentable over the cited references. Additionally, claims 43-44 are further patentable over the cited references, for at least the same reasons earlier discussed for claims 13-14.

Claims 45-49 recite the same limitations of claims 28-32. Accordingly, for at least the same reasons, amended claim 45-49 are patentable over the cited references.

#### Rejections against claims 2, 4, 7, 10 and 11

Claims 2, 4, 7, 10 and 11 depend on claim 1, incorporating its limitations. Linden does not remedy the above discussed deficiencies of Hunt, Scheussler and Moon. Thus, for at least the same reasons, claims 2, 4, 7, 10 and 11 are not obvious, and patentable over the cited references.

#### Rejections against claims 15

Claim 15 depends on claim 1, incorporating its limitations. Kamiya does not remedy the above discussed deficiencies of Hunt, Scheussler and Moon. Thus, for

at least the same reasons, claim 15 is not obvious, and patentable over the cited references.

Rejections against claims 16-19

Claims 16-19 depend on claim 1, incorporating its limitations. Neither Kamiya nor Flemming remedies the above discussed deficiencies of Hunt, Scheussler and Moon. Thus, for at least the same reasons, claims 16-19 are not obvious, and patentable over the cited references.

Rejections against claims 33-38 and 50-55

Claim 33 has been amended to clarify that the emails being organized by the email service provider are emails addressed to the email addresses the email service provider has provided to an electronic device of a user to allow the electronic device to facilitate communication between the user and corresponding first and second communication partners.

Accordingly, for at least some of the reasons discussed earlier, claim 33 is patentable over Hunt. Neither Kamiya nor Flemming remedies the earlier described deficiencies of Hunt. Thus, claim 33 is patentable over the cited references.

Claim 34 is dependent on claim 33, incorporating its limitations. Therefore, for at least the same reasons, claim 34 is patentable over the cited references.

Claims 35 has been amended to clarify the “receiving” and “presenting” operation is performed by an electronic device of a user. While Flemming teaches the filtering of received emails from unauthorized senders, based on entries in an authorized list. Flemming does not teach the required architecture where the analysis of intended and unintended communication partners is performed by the email service provider, and the presentation is by the (client) electronic device. Further, to enable the architecture to work, the email service provider is required to provide the emails to the (client) electronic device with characterization,



characterizing among other things, whether the emails were received from intended communication partners or not. Thus, claim 35 is patentable over the cited references.

Claim 36-38 are dependent on claim 35, incorporating its limitations. Therefore, for at least the same reasons, claims 36-38 are patentable over the cited references.

Claims 50 and 52 contain in substance the same limitations of claims 33 and 35. Accordingly, for at least the same reasons, claims 50 and 52 are patentable over the cited references.

Claims 51 and 53-55 depend on claims 50 and 52 respectively, incorporating their limitations. Thus, for at least the same reasons, claims 51 and 53-55 are patentable over the cited references.

Rejection of claim 42

Applicant is unable to respond to the rejection, since ground for rejection was not provided.

Conclusion

In view of the foregoing, Applicant respectfully submits that claims 1-7, and 9-55 are in condition for allowance, and early issuance of the Notice of Allowance is respectfully requested.

Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,

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Aloysius AuYeung, Reg. No. 35,432  
Attorney for Applicant

Schwabe, Williamson & Wyatt, P.C.  
Pacwest Center, Stes. 1600-1900  
1211 SW Fifth Avenue  
Portland, OR 97204-3795  
503 222 9981 telephone